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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,736	11/15/2000	Gene A. Frantz	TI-29089	3502

23494 7590 10/09/2003

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EXAMINER

GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
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2684

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DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,736

Applicant(s)

GENE A.FRANTZ

Examiner

Tilahun B Gesesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-21 is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-9,22-28,31-39,41 and 43-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Ma et la "Ma"(6,563,805).

As to claim 1, 33,41, Ma discloses a method for downloading and paying for content selected from a digital radio transmission (figure 1) comprising the step of: providing a receiver (4 and 6) capable of receiving digital radio transmissions (column 2, lines 8-17) and a storage device (10 and 25) coupled to the receiver (4 and 6);

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receiving the digital radio transmission at the receiver (a satellite digital audio service receiver 4 and 6), transmitting a request to download the content (column 4 lines 16-28), transmitting information sufficient to allow for payment of the content (column 4, lines 49-67 and figure 1), receiving a transmission authorizing the download of the content (column 4, lines 29-43), and downloading the content to the storage device (column 4, lines 29-43 and figure 1).

As to claims 2,23,32,34 Ma discloses storing the digital radio transmission in a memory buffer at the receiver (column 4, lines 29-43).

As to claim 3, Ma discloses transmission a request to a content agent to download content, the content agent able to initiate the downloading of the content (column 4, lines 16-21).

As to claim 4, Ma discloses the storage device is digital storage device (digital buffer 10 (figure 1).

As to claims 5,24,35, Ma discloses the digital storage device is a portable electronic device (column 5, lines 9-18).

As to claim 6,25,36, Ma discloses the content is coded in a format suitable for digital radio transmission (figure 1).

As to claim 7, 26,37, Ma discloses the content is coded in or compatible with MPEG format or any combination thereof (column 3, lines 8-15).

As to claim 8, 27,38, Ma discloses the download request transmission is a wireless transmission (figure 1).

As to claim 9,28, 39, Ma discloses the wireless transmission is over cellular telephone lines (figure 1).

Claim 22, which recites the steps for implementing the method and in place of claim 1, is rejected for the same reason as set forth in the claim.

Claim 31, which recites the steps for implementing the method, in place of claim 1, is rejected for the same reason as set forth in the claim.

As to claim 43, Ma discloses a method for downloading and paying for content selected from a digital radio transmission received by a receiver capable of receiving a digital radio transmission and coupled to a storage device (column 5 lines 33-39), comprising the step of: receiving payment for a selected amount of content in advance of the digital radio transmission (column 5 lines 40-54) receiving a request for download of the content (column 5, lines 33-39) verifying that the selected amount of content has been paid for in advance, and authorizing the downloading of the content to the storage device (column 6, lines 26-33 and figure 2).

As to claims 44-45, 47, Ma discloses the payment is received in exchange for a prepaid card storage a selected amount of credit suitable for the payment for content and verifying that the prepaid card has stored a sufficient amount of credit to allow for payment of the content and deducting the cost of the content from the credit stored in the prepaid ((column 4, lines 49-54 and 58-67).

As to claim 46, Ma discloses the payment is received in exchange for a smart card storing a selected amount of credit suitable for the payment for content (column 4, lines 49-54).

As to claim 48, Ma discloses the payment is received in exchange for a subscription which allows for the downloading of predetermined content (column 6, lines 26-33).

As to claim 49, Ma discloses the step of verifying that the selected amount of content has been paid for in advance comprises the step of verifying that subscription allows for the downloading of the content (column 6, lines 26-33).

Claim 50, which recites the steps for implementing the apparatus, in place of claim 1, is rejected for the same reason as set forth in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-11,29-30,40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ma et al "Ma" in view of Foladare et al (5,819,160).

As to claims 10-11,29-30,40 and 42, Ma does not expressly disclose the download request transmission is made over an internet connection, video content. However, Foladare discloses request transmission is made over an internet and video content (column 3, lines 45-52 and column 4, lines 10-15. Since, Ma, with similar art of endeavor, discloses the encoding scheme follows one of the motion picture expert group (MPEG) (column 3, lines 8-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ma and

Foladare in transmission of video and internet content to the subscription, as taught by Foladare, since the broadcasting system in a multimedia broadcasting system, which includes video and internet contents.

Allowable Subject Matter

6. Claims 12-21 are allowed over the prior art. The following is an examiner's statement of reasons for allowance: The closest prior art Ma et al (U.S. pat. No. 6,563,805) discloses a system for prepaid recording of digital audio signals 2, via antenna 7, from satellite or terrestrial transmitters and encoded digital signals are fed into a digital buffer 10 and the prepaid recording of digital audio signals, using smart module accepts smart card.

On the other hand, the present application the receiver includes a buffer suitable for storing a selected time period of the digital radio transmission and a storage device coupled to the receiver and places a flag on a discrete content segment of the digital radio transmission; transmitting a request to download the discrete content associated with the flag; receiving a second digital transmission comprising the discrete content segment associated with the flag. These limitation in conjunction with other limitation in the independent claim has not been disclosed or render obvious over the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Janky (5,914,941) discloses a device that is in part a digital replacement for an analog audio tape recorder. The device can record audio programming digitally and can play back audio programming. Where such programming has been digitized and stored in data files using a variety of compression/decompression algorithm (column 5, lines 27-35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

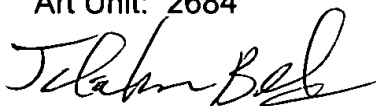
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

TBG

October 3, 2003

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**TILAHUN GESESSE
PATENT EXAMINER**